

No. 6,020,881, Naughton) “and further in view of”² Venkatraman et al (U.S. Patent No. 5,956,487, Venkatraman), or alternatively by Goldberg et al (Web article, Goldberg) and Simmons (Cryptology text)³ followed at the top of page 3 of the outstanding Action by numbered paragraph 6 including an apparent separate rejection of unidentified claims over Naughton and Simmons on unidentified grounds.

REQUEST FOR WITHDRAWAL OF IMPROPER ACTION

As noted above, the top of page 3 of the outstanding Action includes an apparent separate rejection of unidentified claims over Naughton and Simmons on unidentified grounds in numbered paragraph 6 which violates MPEP §707.07(d) because the mandatory word “rejected” and mandatory “ground of rejection fully and clearly stated” are both omitted. With further regard to the MPEP §707.07(d) requirement that each ground of rejection must be fully and clearly stated, the improper use of “anticipated” discussed in footnote 1, the confusion associated with the use of the language “and further in view of” discussed in footnote 2, and the confused state of the alternative reliance upon Goldberg and Simmons discussed in footnote 3, are further violations of this directive.

Besides the confused state as to the actual rejection or rejections applied in the outstanding Action, the rejection and or rejections being applied to Claim 10 are not

U.S.C. §102, not 35 U.S.C. §103, this error clearly requires withdrawal of this improper Action.

²This is clearly the wrong language as it implies that another reference was relied on before the listing of Venkatraman. If another reference was intended to be stated before listing Venkatraman, this error of omission clearly requires withdrawal of this improper Action.

³This alternative grouping of Goldberg and Simmons is not used in the explanation of the Action in terms of Goldberg alone being treated as an alternative to just Venkatraman.

understood. The RCE cover sheet specified the amendment under 37 CFR §1.116 previously submitted on July 26, 2001, was to be entered and this amendment clearly canceled Claim 10. While the outstanding Action acknowledges the filing of the RCE, this continued rejection of canceled Claim 10 and the general non specific treatment of the remaining Claims 1-9 and 11-12 make it appear that the above-noted 37 CFR §1.116 amendment has not been entered contrary to these instructions. The failure of this Action to properly consider the above-noted 37 CFR §1.116 amendment is another reason why this clearly improper Action should be withdrawn.

Furthermore, to the extent that the history associated with any or all of the "REFERENCES CITED BUT NOT APPLIED" is being relied upon, it is clearly improper to list these references relied upon in any manner, even a minor capacity, anywhere other than in a proper statement of rejection. See MPEP §706.02(j) and "*In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n.3 (CCPA 1970)" cited therein. Consequently, any reliance on any historical aspects of remote control should be properly fully and clearly stated and the references included in a properly stated rejection.

RESPONSE TO OBJECTION TO FIGURE 1

Turning first to the objection to Figure 1 that is again presented based upon the oversimplification that Figure 1 shows what is old in the art, it is again noted that the description of Figure 1 at page 17, line 15, through page 18, line 9, in the specification makes it clear that this figure represents a schematic view "of a constitution of a preferred embodiment of the invention." This schematic view of the preferred embodiment includes terminals 1-1 and 1-4 that are shown in more detail in Figure 2 and Figure 3, and not simply providers 3-1 and 3-2 connected to the internet 4. Clearly, the representation of terminals

such as 1-1 and 1-4 in a broad manner in Figure 1 and more specifically in other Figures does not mean that the U.S. Patent & Trademark Office can require the overall schematic view of Figure 1 to be admitted to be "prior art" or that the drawings must each show every detail shown in the other drawings. What is addressed by MPEP §608.02(g) is actual showings of prior art, not a schematic view "of a constitution of a preferred embodiment of the invention" as in Fig. 1. Accordingly, this objection is again traversed because it ignores the existing showings of "1-1" and "1-4" in Figures 2 and 3, for example.

SUMMARY

Before considering the outstanding prior art rejection, it is noted that the present invention is concerned with methods and apparatus for using an encrypted electronic mail based remote reservation control for an electric appliance that stores only commands from certified users.

To whatever extent Naughton teaches remote control of electric devices via a graphical user interface, col. 27, lines 1-3 teach nothing other than sending a remote message over a communications network to invoke a driver program. While such a message can be in a packet as noted in col. 28, lines 8- 32, this teaching of packets is not a teaching the artisan would reasonably refer to as "electronic mail." It is well established precedent that while the PTO is to give claim language its broadest "reasonable" interpretation, this does not mean that the PTO can completely ignore the understanding that the artisan would have of words used in the claims read in light of the specification and to ascribe a completely different meaning thereto. See In re Cortright 49 USPQ 2d 1464, 1467 (Fed. Cir. 1999). ("Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one those skilled in the art would reach.").

In addition, the PTO reviewing court has recently repeated the well established rule that it is error to attempt to extract abstract isolated teachings from a reference taken out of the context taught. See In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[reference] statements cannot be viewed in the abstract. Rather, they must be considered in the context of the teaching of the entire reference.”). The context of Naughton is the use of a hand-held display device for remote control of electric devices via a graphical user interface, not storing control signals retrieved from electronic mail as claimed.

To whatever extent Venkatraman teaches a web server with a user to user interface through a web page, there is no teaching here of the claimed invention and no common ground with Naughton, the Action appears to quickly switch the rejection from one based on Naughton taken with Venkatraman to one based on Naughton taken with Goldberg in paragraph 8 bridging pages 3 and 4 of the Action. However, no matter if the rejection is one based on Naughton taken with Venkatraman or one based on Naughton taken with Goldberg, the rejection relies on subjective conclusions as to replacing the Naughton system and associated network for a system designed to operate over the internet because of the subjective conclusion that the internet “would provide a more general platform with which to base remote control of devices using electronic messages.”

A similar attempt to substitute abstract conclusions as to motivation for a proposed reference modification was recently overturned by the PTO reviewing court in In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) that held that “[w]ith respect to core factual findings in a determination of patentability, however, the [PTO] cannot simply reach conclusions based on its own understanding or experience — or on its assessment of what would be basic knowledge or common sense. Rather, the [PTO] must point to some concrete

evidence in the record in support of these findings. Also note In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) as follows:

The factual inquiry whether to combine references must be thorough and searching. It must be faced on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.

However, dispensing with any “objective evidence” and substituting “subjective belief and unknown authority” as to this question material to patentability is at the very heart of this rejection in clear defiance to Lee at 61 USPQ2d 1434 and at 61 USPQ2d 1435 which notes that the PTO is required to follow binding precedent ([s]ound administrative procedure requires that the agency apply the law in accordance with statute and precedent.) .

Similarly, the attempt to substitute conclusions reached by taking “official notice” for the required evidence of motivation as at the top of page 5 of the outstanding Action is not convincing. Also, adding some type of verification to an encryption system does not follow as many encryption systems rely on nothing more than the inability of the interloper to crack the code. Once again, what is clearly missing is the reasoning why the artisan would select Simmons and its description of certification from all possible encryption options. As further noted by In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998),

[T]he [PTO] must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the [PTO] must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. [Emphasis added.]

Turning to the subject matter of dependent Claims 3 and 4, it is first noted that these claims are respectively dependent on Claim 1 and should be considered allowable for the same reasons that Claim 1 is. In addition, each of these dependent claims further add features that has been improperly dismissed and define patentable subject matter in their own right.

As no further issues are believed to be outstanding in the present application, it is believed that the present application is in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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IN THE CLAIMS

Please cancel Claim 2.

--1. (Three Times Amended) A [receiving apparatus] reception device for controlling an electric appliance, comprising:

[receiving] reception means for receiving an electronic mail transmitted through a network;

first extracting means for extracting encrypted certification information inserted in said electronic mail received by said [receiving] reception means;

second extracting means for extracting a control command inserted in said electronic mail received by said [receiving]] reception means for controlling a remote reservation function of an external video recording device, wherein said control command is [selected by a user of said external video recording device and indicates a manner in which said external video recording device will operate after] added to said [external video recording device is activated] electronic mail to control said electric appliance;

decrypting means for decrypting said certification information extracted by said first extracting means;

certifying means for certifying, by referencing the certification information decrypted by said decrypting means, whether a sender of said electronic mail is an authorized user;
[and]

storing means for storing, if said sender of said electronic mail has been certified by said certifying means to be an authorized user, said control command extracted by said second extracting means; and

control means for controlling said electric appliance based on said control command stored in said storing means, wherein said electric appliance is physically remote from said control means, wherein said control means has a timer reservation function, and wherein said control means reserves an operation time of said electric appliance.

5. (Three Times Amended) A [receiving] reception method for controlling an electric appliance, comprising the steps of:

[a receiving step of] receiving an electronic mail transmitted through a network;

a first extracting step of extracting [an] encrypted certification information inserted in said electronic mail received in said receiving step;

a second extracting step of extracting a control command [inserted in] added to said electronic mail [received in said receiving step for controlling a remote reservation function of an external video recording device, wherein said control command is selected by a user of said external video recording device and indicates a manner in which said external video recording device will operate after said external video recording device is activated] to control said electric appliance;

[a decrypting step of] decrypting said certification information extracted in said first extracting step;

[a certifying step of] certifying, by referencing the certification information decrypted in said decrypting step, whether a sender of said electronic mail is an authorized user; [and]

[a storing step of] storing, if said sender of said electronic mail has been certified in said certifying step to be an authorized user, said control command extracted in said second extracting step; and

controlling said electric appliance based on said control command stored in said storing step, wherein said electric appliance is controlled remotely from a physical location of the second extracting step, and said step of controlling has a timer reservation function, and said step of controlling reserves an operation time of said electric appliance.

8. (Three Times Amended) A [transmitting/receiving apparatus] transmitting/reception system for controlling an electric appliance, [a transmitting side thereof] comprising:

[electronic mail inputting] input means for [inputting] generating at least a portion of an electronic mail;

encrypting means for encrypting predetermined information;

first [adding] addition means for adding, as certification information, the information encrypted by said encrypting means to said electronic mail inputted by said [electronic inputting] input means;

second [adding] addition means for adding a control command [for controlling a remote reservation function of an external video recording device] to said electronic mail [inputted by said electronic mail inputting means, wherein said control command is selected by a user of the external video recording device and indicates a manner in which the external video recording device will operate after the external video recording device is activated] for controlling the electric appliance; [and]

[transmitting] transmission means for transmitting through a network said electronic mail with said certification information added by said first [adding] addition means and said control command added by said second [adding] addition means; [and

a receiving side of said transmitting/receiving apparatus comprising:

receiving] reception means for receiving [an electronic mail] said transmitted [through a network] electronic mail;

first [extracting] extraction means for extracting said certification information [inserted in] from said electronic mail received by said [receiving] reception means;

second [extracting] extraction means for extracting said control command [inserted in] from said electronic mail received by said [receiving] extraction means;

decrypting means for decrypting said certification information extracted by said first [extracting] extraction means;

certifying means for certifying, by referencing said certification information decrypted by said decrypting means, whether a sender of said electronic mail is an authorized user; [and]

storing means for storing, if said sender of said electronic mail has been certified by said certifying means to be an authorized user, said control command extracted by said second [extracting] extraction means; and

control means for controlling said electric appliance based on said control command stored in said storing means, wherein said electric appliance is physically remote from said control means, wherein said control means has a timer reservation function, and wherein said control means reserves an operation time of said electric appliance.

9. (Three Times Amended) A [transmitting/receiving] transmitting/reception method for controlling an electric appliance, [a transmitting side thereof] comprising the steps of:

[an electronic mail inputting step of] inputting information to generate at least a portion of an electronic mail;

[an encrypting step of] encrypting predetermined information;

a first adding step of adding, as certification information, information encrypted in said encrypting step to said electronic mail inputted in said [electronic] inputting step;

a second adding step of adding to said electronic mail a control command for controlling [a remote reservation function of an external video recording device to said electronic mail inputted in said electronic mail inputting step, wherein said control command is selected by a user of the external video recording device and indicates a manner in which the external video recording device will operate after the external video recording device is activated] the electric appliance ;

[and a] transmitting [step of transmitting] through a network said electronic mail with said certification information added in said first adding step and said control command added in said second adding step;

[a receiving side of said transmitting/receiving method comprising:]

[a] receiving [step of receiving an] said transmitted electronic mail [transmitted through a network];

a first extracting step of extracting said certification information [inserted in] from said received electronic mail [received in said receiving step];

a second extracting step of extracting said control command [inserted in] from said received electronic mail [received in said receiving step];

[a] decrypting [step of decrypting] said certification information extracted in said first extracting step;

[a] certifying [step of certifying], by referencing said certification information decrypted in said decrypting step, whether a sender of said electronic mail is an authorized user; and

[a] storing [step of storing], if said sender of said electronic mail has been certified in said certifying step to be an authorized user, said control command extracted in said second extracting step; and

controlling said electric appliance based on said control command stored in said storing step, wherein said electric appliance is controlled remotely from a physical location of the second extracting step, and said step of controlling has a timer reservation function, and said step of controlling reserves an operation time of said electric appliance.--